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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/611,196

Filing Date: July 06, 2000

Appellant(s): SMITH ET AL.

John Harrity
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/30/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because all the claims 8-13, 19, 20, 23 27 and 29 should stand or fall with its independent claims.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5513117	SMALL	04-1996
5570081	HOLSTROM	10-1996
5684291	TASKETT	11-1997

6385860

MACWILLIAMS ET AL.

05-2002

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 U.S.C. '103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24 and 28-29 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291).

Regarding claim 1, Holstrom teaches a calling card with a card portion and a key tag portion with information on the card to direct a user to call a number and a PIN associated with the card (see figs. 1-2). According to the disclosure, the card can be made of paper, plastic and so forth with a scope comparable to a conventional credit card (see col. 2 lines 47-53). Holstrom fails to teach that the card is separable into a two-piece portion by means of a *perforation* even though the claim simply calls for separation, but for the sake of argument and based on the applicant's figs.

Taskett teaches a repaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two

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portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations inorder to be able to keep articles such as keys on the key tag section inorder to avoid losing one=s keys.

Regarding claim 3, the combination including Holstrom teaches a card with a key tag hole through which a key can be inserted in (see figs.).

Regarding claim 4, see the explanation as set forth regarding claim 1.

Regarding claim 6, the combination including Holstrom in (see figs.) Teaches an identification number and a telephone number on both portions of the cards in (see figs. 1-2) when turn on both sides.

Regarding claim 7, Holstrom teaches a calling card with a card portion and a key tag portion with information on the card to direct a user to call a number and a PIN associated with the card (see figs. 1-2). According to the disclosure, the card can be made of paper, plastic and so forth with a scope comparable to a conventional credit card (see col. 2 lines 47-53). The personal information would simply read on the card user identifier such as displayed by Holstrom on (see fig. 1). Holstrom fails to teach that the card is separable into a two-piece portion by means of a perforation even though the claim simply calls for separation, but based on the figs.

Taskett teaches a repaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations inorder to be able to keep articles such as keys on the key tag section inorder to avoid losing one=s keys.

Regarding claims 8-11, The combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett.

Regarding claims 13-14, the combination teaches the claimed subject matter in (see figs. of Holstrom).

Regarding claim 16, see the explanation as set forth as set above in claims 1 and 7 in addition to the fact that obviously a plurality of cards would be manufactured using plurality of blanks cards initially and a computer means with a software means would have to implement and encode the cards with information to be utilized by a user. The customized multipurpose card reads on the card as taught by Holstrom in conjunction with Taskett.

Regarding claims 17-19, The combination teaches the claimed subject matter.

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Regarding claim 22, see the explanation as set forth regarding either claim 1 or 7 because customizing the card reads on the teaching as taught by the combination which could include a unique identifier or identifier associated and displayed on the card.

Regarding claims 21 and 24, The combination including Holstrom teaches being able to add an identifier on both portions of a card.

Regarding claim 28, Holstrom teaches a card which would be manufactured to have the size (scope) of a conventional card similar to a credit card with two portions which can be separate from each other with one portion comprising of a key tag (see figs. and disclosure). Holstrom fails to teach being able to separate the card into two portions by means of perforations. Separating articles from each other by means of perforations is notoriously well known.

Taskett teaches a prepaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations inorder to be able to keep articles such as keys on the key tag section inorder to avoid losing one=s keys.

Regarding claim 29, The combination teaches use of perforation in (see Taskett) and the number of perforations would be a design choice.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291) and further in view of Small (US Pat# 5,513,117).

Regarding claim 2, The combination fails to teach the possibility of being able to personalized the card to include personal information as *desired by the user of the card even though this limitation is not specifically directed to the claimed subject matter*. It=s notoriously well known to have designs or advertisements by a card producer or telephone provider displayed on a calling card. Small teaches an apparatus for dispensing personalized gifts wherein a user can personalize information on a gift which according to Small could include prepaid telephone calling cards

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of the combination thus making it possible to provide advertisement information to card users and if the card is a gift, being able to personalize a card for the recipient.

4. Claims 7, 12, 15, 16, 20, 22, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom in view of Small (US Pat# 5,570,081).

Regarding claims 7 and 22, Holstrom teaches a customized card which includes personal information which reads on the Acard identifier@ wherein according to Holstrom, the card can be separated into two portion to include a key tag portion through which a key chain can be inserted in (see figs.). *The fact that the card is to be*

customized by the user or the party purchasing the card to include the Personal information@ is not directed to the claimed subject matter but for the sake of argument, Small teaches an apparatus wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card which can be used for making a call as a gift to a recipient.

Regarding claim 12, see the explanation as set forth in the rejection of claim 7.

Regarding claim 15, Holstrom teaches a multi-purpose card including a main portion and a key tag portion separable from each other in (see figs.) but fails to teach the limitation being able to customize information on the card as specified by a user.

Small teaches an apparatus and system wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card, which can be used for making a call, as a gift to a recipient.

Regarding claim 16, see the explanation as set forth regarding claim 7 in addition to the fact that a computer process would initially encode blank cards with information

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on the card wherein the information could include the standard information comprising of a unique PIN, the telephone number to call for activation and any personalized message as desired by the user in conjunction with the other information.

Regarding claim 20, The combination teaches being able to customize a card to include information which could include personal expression.

Regarding claim 23, see the explanation as set forth regarding claim 22.

Regarding claim 25, Holstrom teaches a multi-purpose card with a main portion and a key tag portion in (see figs.) with personal information (card identifier) on both sides of the card portions but fails to teach receiving a request from a user or purchaser of the card to customize a personalized expression on the card.

Small teaches an apparatus and system wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card, which can be used for making a call, as a gift to a recipient.

Regarding claims 26-27, The combination including Holstrom teaches the claimed subject matter.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291) and further in view of Marc-Williams et al. (US Pat# 6,385,860).

Regarding claim 30, The combination fails to teach the claimed subject matter but MacWilliams teaches a label and method for applying in (see fig. 1) wherein a label can be placed on perforation to protect the perforated means in (see figs. 1, 5 and disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this teaching into that of the primary references as means of providing a label covering the two-piece perforated piece for protection purposes.

(11) Response to Argument

(I) The appellant argued in (see page 5-6) the combination as set forth in the rejection of the claimed subject matter including Holstrom and Taskett.

The examiner disagrees because Holstrom teaches a card identifier which can be used in accessing a service of a telecommunication network wherein according to Holstrom, the card will have a scope similar to that of a credit card relevant to the size of the card. The examiner applied a secondary reference which teaches a card identifier or account identifier (prepaid card) which can be used in accessing a communication network services, as well separation of card into two pieces via perforations even though this limitation is not directed to claim 1. Furthermore, see the motivation given for the combination.

(II) The appellant argued that a primary reference applied (Holstrom) fails to teach a multipurpose calling card that includes a calling card portion and a key tag portion.

The examiner disagrees because the combination including Holstrom teaches a card, similar in scope to a credit card, with which one can make a telephonic connection to obtain a telephone service based on an identifier, unique or associated with the card over a network comprising of two portions including a tag portion and a key ring portion (see abstract, figs. 1-3). According to Holstrom, one has to dial a 800 number to be connected and then prompted for the identifier (18, 20 of fig. 1) after which one can be given access to a voice mail system connected somewhere in the network and possibly associated with a service provider given the fact the dialed number (800) would have to be completed by a telephone service provider in (see col. 13-22 of Holstrom). Thus, the explanation as set forth regarding the limitations believed to be proper and permissible.

(III) The applicant argued on (page 8 line 18-page 9) that the combination including Holstrom and Taskett fails to teach a multi-purpose calling card *approximately* the size of a conventionally calling card.

The examiner disagrees because the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the "calling" card such as taught by Holstrom. Furthermore, according to Holstrom in (see col.2 lines 49-51) the card can have a scope similar to that of a standard credit card and also, all calling cards do not have the same size. Another feature is that the limitation calls for "approximately" which would be rendered obvious by the combination based on the explanation given above. Also, all calling cards do not have the same size.

(IV) The appellant argued in regard to claim 7 (see page 10) that the combination fails to teach receiving personal identification and encoding each multi-purpose card

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including a main portion and a key tag portion with the information on at least one of the portion namely; main or key tag portion.

The examiner believes the explanation as set forth in the rejection of this limitation is believed proper and permissible and see the explanation as set forth in the rejection regarding claim 7. The examiner disagrees because personal information is broad and thus can be read on a unique identifier such as a PIN on an article. The combination including Holstrom teaches in (see fig. 1), unique or if not unique an identifier associated with a card with which one can make a telephone connection to a remote station.

In response to the appellant's argument in specifically (see page 11) that Holstrom doesn't give a user (owner) the flexibility to customize the card,

The examiner has re-iterated during the course of prosecution that the fact that the personal information can be information customized by a user/purchaser is not directed to the claimed subject matter (claim 7). Note that the card in question (claim 7) could be a multi-purpose card which according to the applicant could be a prepaid card, credit card, gift card or the like in (see page 2 of the appellant's argument titled "Summary of the Invention").

The limitation "customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information" would in narrow terms imply that the main and key tag portion could include personal information which would read on the identifier (18, 20 of fig. 1 of Holstrom) imprinted on the card portions.

(V) The appellant argued in (see pages 12-17) argued that the combination as set forth in the rejection of the claimed subject matter fails to teach a multi-purpose calling card, multi-purpose prepaid telephone cards, gift cards as set forth in claims 8-11.

The examiner strongly disagrees because the combination as set forth regarding Holstrom teaches a multi-purpose "calling" card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination (design wise) could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious.

(VI) The appellant argued in (see pages 17-18) that the combination as set forth in the rejection of claim 13 fails to teach a personal information because an identifier used by the examiner as an equivalent to the personal information is incorrect.

The examiner disagrees and believes the explanation as set forth regarding the claimed subject matter is proper and permissible. Furthermore, see explanation (IV) as set forth above.

(VII) The appellant argued in (see page 19) that the combination fails to render obvious the subject matter of separating a main portion from a key portions by means of five perforations.

The examiner disagrees because the combination teaches the possibility of being able to use perforations in separating one portion of a card from the other but doesn't specifically limit or mention the number of perforations required to do so. Thus,

the examiner in rejecting the claimed limitation believes the combination would render the limitation obvious in part based on design choice in addition to the fact that there is no restriction on the number of perforation set forth by the combination.

(VIII) The appellant argued in (see pages 20-22) that the prior art of record fails to teach being able to customize a card with personal information by a user wherein the information is placed on the key ring portion of the card.

The examiner disagrees because in rejecting the claimed subject matter, the examiner tried to show that being able to customize a card to include any desired information including personal expressions like greetings and so forth is well known such as taught by Small. In response to the appellant's argument that the fact that card is to be customized by a user or purchaser is not directed to the claim but implying that the card could include personal expressions as one of the options which according to the appellant's disclosure could be a picture of family, messages such as congratulations and so forth could mean that a user or purchaser could place any desired personal information on the card as a gift such as taught by Small.

Placing company logos or advertising information on a card is also notoriously well known.

It would have been obvious to one of ordinary skill in the art that desired information can be placed anywhere on the card as desired by a user or purchaser wherein the personal expressions could including messages or greetings such as taught by Small. The combination including Holstrom teaches personal information (Identifier) on both portions of the card and the possibility of replicating information on both

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portions. Furthermore, the combination including Small teaches being able to customize gifts including calling cards in (see abstract, fig. 10, col. 3 lines 5-10 and so forth) to include any promotional information, expressions and so forth on both portions. See the explanation as set forth regarding claim 2 and note that motivation can be found in the title and disclosure of Small.

(IX) The appellant's arguments in (see pages 24-26) have already been addressed in the explanation as set forth above including Sections II, IV and VIII.

(X) The appellant argued in (pages 26-29) that the motivation for the combination including Small is based on hindsight and lacks motivation.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The primary art of record teaches customizing a card to be used when calling or acquiring a communication service wherein the card has customized information including a telephone number to call and an identifier, possibly unique, on both portions of card which includes a main portion and key portion. It's known to purchase cards through a vendor, point of sale terminal and so forth. According to Small, a blank or imprinted card s can be customized as desired with any desired information for gift

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purposes. The combination is believed proper and permissible since no restriction is placed on where the "calling" card taught by Holstrom can be obtained.

(XI) The appellant argued that the combination including MacWilliams et al lacks motivation and is based on hindsight because Holstrom does not suggest a desire to place a label.

The explanation as set forth regarding claim 30 was based on a combination of references but the appellant has attacked the references individually. The combination including Holstrom and Taskett teaches the possibility of using perforations to separate a card into two portions based on Taskett's teaching of using a perforation for such purpose. Furthermore, the examiner has supplemented the combination with that of MacWilliams to teach the possibility of placing a label member on perforations for stock members for protection purposes and to avoid the possibility of accidentally tearing the cards.

(XII) The appellant argued that the combination including MacWilliams fails to teach a label placed on perforations and pointed to some disclosure for support.

The examiner disagrees because the entire means (100) for instance is called a label and (101) is called a label member placed over perforations, which extends to cuts, which can still be considered perforations possibly in a large form, which can be applied to article. Thus, if the combination including Taskett is found to be permissible, the idea of being able to apply label member over a perforation should be render obvious based on the teaching of MacWilliams.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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PRIMARY EXAMINER
03/17/04

March 17, 2004

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